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HOFFMAN WARNICK & D'ALESSANDRO, LLC 3 E-COMM SQUARE ALBANY, NY 12207			WOODS, ERIC V	
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DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/633,948	GAMBLE, WILLIAM
	Examiner Eric V. Woods	Art Unit 2672

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –  
Period for Reply

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 25 May 2005.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-21 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-21 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

**DETAILED ACTION*****Response to Arguments***

1. Applicant's arguments filed 17 December 2004 have been fully considered but they are not persuasive. Namely, applicant contends on Remarks pages 1-2 that the combination of references does not teach the recited limitations. Firstly, applicant contends on page 1 that saving a composite image would not be obvious. As noted by examiner and applicant, Yokouchi does not specifically teach this limitation.
2. However, applicant acknowledges that the Anderson reference (see Remarks pages 1-2, specifically the last few lines of page 1) teaches saving the **components** of such an image. Further, Anderson teaches printing the image as noted by applicant (Pg. 4, paragraph [0053]) on Remarks page 2.

Firstly, to properly resolve the issue, a brief inquiry under *Graham v. Deere* will be illustrative. The prior art clearly teaches that saving images is within the scope of one of ordinary skill in the art, as saving files has been known since the advent of personal computers, with its attendant advantages.

Secondly, another feature of the personal computer is illustrative. The "Print Screen" / "SysRq" key in most operating systems (Windows™ 3.1, NT, etc.; Linux; and others) generates a screen capture, where the contents of the screen are placed into the clipboard and/or sent to the printer. Since the 1980s, most operating systems (particularly Windows™) have come with utilities alternately known as "paint programs". Such programs provide rudimentary image manipulation capabilities, but most importantly allow the user to transfer such screen captures from memory to the actual

application, and then to be saved as a derivative file (JPEG, BMP, GIF, PNG, various other known algorithms and image formats). This is known as a 'paste' operation, and the entire process is known colloquially in the art as a "cut and paste" operation. Now, there have also been sophisticated image manipulation programs available for personal computers since the advent of the PC (see the Apple II, and many others) in the 1980s, with examples being programs from Apple® Computer, Adobe® Systems, and many others, and it has been well known since that time to save images as well.

The point of this exercise is to point out that such capabilities are inherent in PC hardware and low-level operating systems. Secondly, in the 1980s that key typically served a **literal** function, in that it actually sent the screen image directly to an output-printing device. In Microsoft DOS (Disk Operating System), which was the standard in the late 1980s and early 1990s, pressing the Print Screen key would literally send the image or output of the screen to the printing device (see attached Dictionary I, Dictionary II references for one notation of this).

Therefore, the process of capturing the screen requiring storing a copy of the screen in memory, from which it could just as easily be saved; printing it requires that the screen capture be digitized and sent to the printer in any case.

Now that accomplishes the first item under Graham v. Deere, "determining the scope and contents of the prior art". Since examiner has established that saving an image is well known in the art and trivially obvious besides, the next inquiry is to ascertain the differences between the prior art and the claims at issue.

The sole issue raised by applicant in the rebuttal to examiner's case of prima facie obviousness has been whether or not it would have been obvious to save the image. Indeed, applicant states on Remarks page 2, *inter alia*, "Thus, the saved components and printed image/template composite of Anderson are not equivalent to saving the composite image based on the composite image template and the at least one image as included in the claimed invention."

Obviously, as stated above, the file would be stored in the computer's memory, be it in the frame buffer, system clipboard, main memory, etc. As stated above, saving the file from there is a trivially easy task (e.g. using Microsoft® Paint, or simply piping the digital file to a operating system hook and directly writing it to a file, e.g. the *grep* command under Unix or similar, with the results being piped to a file using the | operator (pipe). In any case, examiner now turns to the third inquiry of determining the level of ordinary skill in the pertinent art, which has been accomplished above.

There is no objective evidence in favor of non-obviousness presented by applicant. As such, examiner concludes for the reasons above – this concluding the *Graham* inquiry – that saving a file would indeed be obvious, and equivalent to "saving the components of the image" and "printing the image" for the reasons set forth above.

3. As to the addition of "graphical user interface" to claims 2, 12, and 18, that recitation basically has no meaning, as it is obvious that both references teach GUI-based operating systems and environments.

Applicant amended the claim to include that the creation of such templates used a graphical user interface. Clearly, the assertion that Yokouchi does not teach this

limitation is mistaken. For example, Yokouchi Fig. 13 shows a sample composite image, and in Fig. 14 the user is shown changing the editing description of a template, and Fig. 27 shows the template while Fig. 28 shows the template description. Now, clearly such descriptions would be displayed on a monitor. A “graphical user interface” in the computer arts is well known to be anything that involves visual depiction and interaction with the user, e.g. windows and such – clearly the description of the template is in a window, as are the templates that are generated, and they are clearly graphical.

Secondly, Anderson clearly teaches that the templates used therein have multiple planes of images (see for example Figs. 5A – 5B). Clearly, the user can manipulate those planes (see Fig. 7) and the graphical data contained therein [0047]. Anderson saves storage space by embedding tags concerning position of elements within each plane. Figures 10 and 11 show a template being manipulated in a GUI environment, and in [0043-0044] it clearly states that a template designer can override tags from a plane file, so clearly if a template designer can alter them in the windows shown in Figs. 10 and 11, then clearly those alteration at least could be and in all probability would be done in the window, e.g. in what is inherently a graphical user interface environment.

In short, both references teach this limitation, it is well known in the art and is trivially obvious, and applicant's arguments are moot. Finally, again, both systems run in windowed operating systems using monitors, which are inherently “graphical user interface” environments, and thus an inherency holding is also valid against that recitation.

4. One final point – applicant argues that his system generates the composite image template file using a graphical user interface. However, this file is not specified to be graphical. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the composite image template file being graphical) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, as specified in the rejection to claim 1 – and as pointed out in the above arguments, Anderson teaches multiple planes of an image, and when images are embedded in a layer, it would be obvious that the entire file – layers and all – would be saved. Therefore, the argument is moot for at least the above reasons.

5. Examiner further submits that regardless of applicant's statement in Remarks, first paragraph, page 1, that the amendments to claims 2, 12, and 18 were for reasons related to patentability, e.g. to overcome prior art under 35 U.S.C. 103(a). Further, applicant's statement therein only stated that applicant did not acquiesce in the correctness of any rejections, not that such amendments were **not** made for reasons relating to patentability. As such, the amendments constitute a narrowing of claim scope and thus fall under the doctrine recognized in *Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd. (Festo III, 2000)*.

Therefore, applicant's arguments stand rebutted and the finality of this Office Action is appropriate.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yokouchi (US 2001/0004258 A1)('Yokouchi') in view of Anderson et al (US 2003/0206316 A1)('Anderson'). [Please note: for all the claims below, examiner will be using the term "template" as synonymous with the "composite image template" of applicant because all the references utilized by Examiner use the term "template" in that context, and all the templates discussed or disclosed in references will be for combining images, thus such templates are *prima facie* "composite image templates".][Claims 11 and 16 and their dependent claims are rejected under the same arguments and references as claim 1; claim 11 merely recites a system implementing the method of claim 1, and claim 16 is software implementing the method of claim 1, which is a *prima*

facie obvious variation, as both references utilized in these rejections teach software (Anderson 0003, 0030, etc.; Yokouchi all claims (pg. 11, they all recite computer-readable medium). Therefore, such rejections are binding on claims 11 and 16 and their dependent claims without further comment.]

9. As to claims 1, 11, and 17,

A method of creating a composite image, comprising:

- Providing a composite image template that includes at least one image area; (Anderson 0003, Fig. 6, Fig. 11, etc.; Yokouchi Figs. 27 and 30, multiple image areas provided, 0009, 0012 and many others) and
- Associating at least one image with the at least one image area (Anderson Figs. 6 and 7 for example (0038, 0042-0044, etc.); Yokouchi 0138-0141, pictures P0 (background) from Fig. 3 and picture P1 from Fig. 5 are composited with P1 being put into the location specified by the user); and
- Saving the composite image based on the composite image template and the at least one image (0047 Anderson, and Fig. 1 Anderson, where images are initially stored in camera storage 120 and merged with templates from the template storage 150 and saved in the computer 130.).

The entire Response to Arguments section is herein incorporated by reference.

Reference Yokouchi teach all the limitations of the claim, with the individual claim limitations addressed specifically above. Yokouchi never explicitly teaches saving the image. It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the image templates of Yokouchi with those of

Anderson, since Anderson explicitly teaches saving images, which would allow manipulation of the composited images at a later time, and their use in later templates, as well as utilizing the three-layer image compositing scheme, which would allow the use of multi-layer templates, which would be an important improvement over Yokouchi.

10. As to claims 2, 12, and 18,

The method of claim 1, further comprising generating a composite image template file that describes the composite image template using a graphical user interface (Anderson 0012, 0014, 0023).

Reference Yokouchi does not teach this limitation explicitly, but rather implicitly as in 0014-0017, where the template files are taught to have several portions that describe various aspects of the images and file. Anderson teaches this limitation as cited above, where composite image files are referred to as well as methods for creating such files.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the image templates of Yokouchi with those of Anderson, since Anderson explicitly teaches saving images, which would allow manipulation of the composited images at a later time, and their use in later templates, as well as utilizing the three-layer image compositing scheme, which would allow the use of multi-layer templates, which would be an important improvement over Yokouchi.

Applicant amended the claim to include that the creation of such templates used a graphical user interface. Clearly, the assertion that Yokouchi does not teach this limitation is mistaken. For example, Yokouchi Fig. 13 shows a sample composite image, and in Fig. 14 the user is shown changing the editing description of a template,

and Fig. 27 shows the template while Fig. 28 shows the template description. Now, clearly such descriptions would be displayed on a monitor. A “graphical user interface” in the computer arts is well known to be anything that involves visual depiction and interaction with the user, e.g. windows and such – clearly the description of the template is in a window, as are the templates that are generated, and they are clearly graphical.

Secondly, Anderson clearly teaches that the templates used therein have multiple planes of images (see for example Figs. 5A – 5B). Clearly, the user can manipulate those planes (see Fig. 7) and the graphical data contained therein [0047]. Anderson saves storage space by embedding tags concerning position of elements within each plane. Figures 10 and 11 show a template being manipulated in a GUI environment, and in [0043-0044] it clearly states that a template designer can override tags from a plane file, so clearly if a template designer can alter them in the windows shown in Figs. 10 and 11, then clearly those alteration at least could be and in all probability would be done in the window, e.g. in what is inherently a graphical user interface environment.

In short, both references teach this limitation, it is well known in the art and is trivially obvious, and applicant’s arguments are moot.

[Note that for claim 12’s additional limitation of having the image display system use the composite image template file, this is a trivial modification, and further the system of Yokouchi teaches in Fig. 1 that a monitor 8 is used, which is controlled by the “composition means” 5 and pulls the files from the template storing means 1, which fulfills any additional limitations of claim 12. Further, the term “uses” in this context can

only be taken to mean that the image display system displays the template file, as well as using it as a file descriptor.]

11. As to claim 3,

The method of claim 2, wherein the generating step includes adding a first image area to the composite image template.

Reference Yokouchi teaches all the limitations of this claim, for example 0036-0040, where 0037 sets a valid area in a two-dimensional plane and 0038 sets layout areas in the valid area and so forth. Since only the primary reference is cited, no separate combination or motivation is necessary and that of the parent claim is adopted via incorporation without further comment.

12. As to claim 4,

The method of claim 3 wherein the generating step further includes adding a second image area to the composite image template.

Reference Yokouchi teaches all the limitations of the claim, as in claim 3 (0036-0040) various methods of laying out images, and in 0038, layout areas in the valid two dimensional image area are created – specifically, “specifying a plurality of layout areas” and “specifying the plurality of layout images laid out in the respective layout areas.” These are clearly cited as part of creating a composite image template. Since only the primary reference is cited, no separate combination or motivation is necessary and that of the parent claim is adopted via incorporation without further comment.

13. As to claim 5,

The method of claim 4, where the second image area and the first image area overlap.

Reference Yokouchi teaches all the limitations of the claim. For example, Figs. 47A and 47B are specified to have overlapping images (0009) and prior art is disclosed by Yokouchi to have overlaps. In 0078 and 0178, it is specified that since the images are inserted one at a time, none of them overlap – but the important distinction is that **none of the images overlap because they are inserted one at a time to allow the user to control positioning and overlap during the compositing process**. In any case, in light of the prior art revealed by Yokouchi (under MPEP 2123, patents are relevant for all they contain and disclose, including prior or conventional art) it would have been obvious to modify the compositing process of Yokouchi to include the ability to have overlapping images after compositing – e.g. each element would be laid out in layers so that they could be seen individually without the alpha-channel bleeding problem of the prior art.

14. As to claim 6,

The method of claim 2, wherein the generating step includes selecting background attributes of the composite image template.

Yokouchi teaches layout areas and insertion areas for images, which implicitly fulfill all the limitations of this claim. Reference Anderson explicitly teaches this limitation, as in Fig. 3 where it is shown that Anderson's templates have three layers – element 310, the foreground, element 320, the actual image, and element 330 the background (0032). Each layer can be independently specified – see Figs. 5A and 5B where the background plane is specified to have either a plurality (5A) or one (5B) graphic files in that layer. It would have been obvious to one having ordinary skill in the

art at the time the invention was made to combine the image templates of Yokouchi with those of Anderson, since Anderson explicitly teaches specifying the background layer, which would allow manipulation of the composited images at a later time, and their use in later templates, as well as utilizing the three-layer image compositing scheme, which would allow the use of multi-layer templates, which would be an important improvement over the semi-layered layout of Yokouchi, which would gain additional versatility by allowing the use of explicit foreground and background layers.

15. As to claim 7,

The method of claim 2, wherein the generating step includes adding at least one template image file to the composite image template.

In the broadest sense, Yokouchi defines a template in 0005. However, Yokouchi further enhances that description such that a template contains descriptive language (e.g. 0037-0042, for example) the position of all the images, the layout areas, etc, and *prima facie* the system can combine multiple images, backgrounds, etc. In light of Anderson, which teaches the combination of multiple layers of images (see rejection for claim 6), obviously previously rendered composite images could be combined in the same way. Given that Yokouchi basically states that templates are reduced to editing descriptions (mentioned 0120), it would be obvious to modify the system such that templates could be combined. Each template would have its own editing descriptions and page language descriptors, which would yield easy combinations of templates to get a final product – just as two composited images can further be combined or composited, two templates can obviously be processed in the same way.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the image templates of Yokouchi with those of Anderson, since Anderson explicitly teaches specifying the background layer, which would allow manipulation of the composited images at a later time, and their use in later templates, as well as utilizing the three-layer image compositing scheme, which would allow the use of multi-layer templates, with the emphasis that the editing descriptions – essentially a page description language, or some kind of overall format (e.g. XML), would allow the production and combining of previously existing templates as discussed above, which would give the system of Yokouchi increased versatility since it would be easy to combine excellent past works and produce a superior new product template.

16. As to claim 8,

The method of claim 1, further comprising adjusting the at least one image to conform to the associated image area.

Reference Yokouchi does not explicitly teach this limitation. Reference Anderson teaches in Figs. 8A-8C the adjustment of an image to fit the image area that it would go in, and further teaches the use of cropping, rotating, skewing, etc (0003) to make images fit in specified image areas in templates.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the image templates of Yokouchi with those of Anderson, since Anderson explicitly teaches adjusting the image to fit in the area – that is, allowing the user to adjust it to their preferences, not having such an action done automatically, which would greatly enhance the functionality of Yokouchi and enable it

to accommodate oddly shaped images and allow the user more control over the final composite image, as that is the stated goal (and differentiation from the prior art) of both Yokouchi and Anderson.

17. As to claim 9,

The method of claim 8, wherein the adjusting step comprises at least one of: clipping, rotating, stretching, and skewing the at least one image.

Reference Yokouchi does not explicitly teach this limitation. Reference Anderson teaches in Figs. 8A-8C the adjustment of an image to fit the image area that it would go in, and further teaches the use of cropping, rotating, skewing, etc (0003) to make images fit in specified image areas in templates. (Same as claim 8, the image manipulation is the only difference).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the image templates of Yokouchi with those of Anderson, since Anderson explicitly teaches adjusting the image to fit in the area – that is, allowing the user to adjust it to their preferences, not having such an action done automatically, which would greatly enhance the functionality of Yokouchi and enable it to accommodate oddly shaped images and allow the user more control over the final composite image, as that is the stated goal (and differentiation from the prior art) of both Yokouchi and Anderson.

18. As to claim 10,

The method of claim 1, wherein the saved composite image comprises an image file.

Reference Yokouchi does not this limitation explicitly. Anderson teaches this limitation as cited above, where composite image files are referred to as well as methods for creating such files. Anderson explicitly teaches saving files (0047) and it is so well known in the art as to be a fundamental to save images after processing, and in Figs. 6A and 6B Anderson shows how each layer can be composed of one or a plurality of image files that *prima facie* would have been saved or stored somewhere. It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the image templates of Yokouchi with those of Anderson, since Anderson explicitly teaches saving images (0047, image files are stored separately from combination instructions), which would allow manipulation of the composited images at a later time, and their use in later templates, as well as utilizing the three-layer image compositing scheme, which would allow the use of multi-layer templates, which would be an important improvement over Yokouchi.

19. As to claims 13 and 19,

The system of claim 12, wherein the template definition system includes:

-A template display system for displaying the composite image template; (Yokouchi 0014-0017, the template files are described and *prima facie* the image composition means 5 in Fig. 1 would display the templates from the template storing means 1 on the monitor 10, and further in 0129, Yokouchi discloses the display of images during the composition process.]

-A background system for selecting background attributes of the composite image template [Yokouchi teaches the ability to add various background components (0135),

e.g. the white fringe shown in Fig. 7. Anderson teaches in Fig. 3 the use of multiple layers for compositing templates, one of which is the background, and is independently selectable and configurable; in Figs. 6A and 6B, the background is shown as having one or a plurality of images composing it, and in Figs. 6 and 7 the layout tool and layout of the images on the background is shown];

-An image area system for adding an image area to the composite image template (Reference Yokouchi teaches this limitation, for example 0036-0040, where 0037 sets a valid area in a two-dimensional plane and 0038 sets layout areas in the valid area and so forth);

-A template file system for saving the composite image template as a composite image template file (Fig. 1 of Yokouchi shows a template storing means 1; Fig. 2 of Anderson shows templates stored in printer storage 250. Further, Anderson 0006-0007 and 0031 teaches an object-based template model. Finally, for templates to be used after composition they must be saved, and saving files is a fundamental of computer-based art. If necessary, it would have been trivially, *prima facie* obvious to modify the software of Anderson and Yokouchi to do so. Finally, the use of a template storing means clearly requires and inherently has a “template file system” as the term “file system” is conventionally used in the computer art.)

Reference Yokouchi does not explicitly teach the ability to completely, independently select background components, but explicitly teaches all other limitations. Reference Anderson explicitly teaches the ability to select backgrounds for templates independently. It would have been obvious to one having ordinary skill in the art at the

time the invention was made to combine the image templates of Yokouchi with those of Anderson, since Anderson explicitly teaches saving images (0047, image files are stored separately from combination instructions), which would allow manipulation of the composited images at a later time, and their use in later templates, as well as utilizing the three-layer image compositing scheme, which would allow the use of multi-layer templates, which would be an important improvement over Yokouchi.

20. As to claim 14,

The system of claim 13, wherein the template definition system further includes a template image system for associating a template image file with the composite image template.

Reference Yokouchi does not explicitly teach this limitation, although implicitly teaching it (for example, the addition of the white fringe to Fig. 7, as discussed in 0135).

Reference Anderson clearly teaches (0006-0007, 0031-0034) that image files are associated with plane files for template construction via a system of tags embedded in the files. This clearly meets the above-recited limitations; also, Anderson in Figs. 6A and 6B clearly shows how each plane file can have one or a plurality of image files associated with it. It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the image templates of Yokouchi with those of Anderson, since Anderson explicitly teaches saving images (0047, image files are stored separately from combination instructions), which would allow manipulation of the composited images at a later time, and their use in later templates, as well as utilizing the three-layer image compositing scheme, which would allow the use of multi-

layer templates, which would be an important improvement over Yokouchi. [System limitation is no different than method, as both are implemented in software, and it is a fundamental of the software art that one can build software having any combination of modules that will perform the same functions, thus taking care of any potential limitations there.]

21. As to claim 15,

The system of claim 11, wherein the association system displays the associated at least one image within the at least one image area.

Reference Yokouchi very clearly teaches in 0134-0137 that associated images are displayed in the target area, with a result or example being Fig. 13. Since only the primary reference is utilized, no separate motivation or combination is required and that of the parent claim is hereby incorporated by reference without further comment.

22. As to claims 16,

The system of claim 11, further comprising a thumbnail system for displaying a template image that is associate with the composite image template.

Reference Yokouchi very clearly teaches a thumbnail system for displaying composite image templates in Fig. 11 and discusses the system in 0130 and provides examples of its use in 0137-0138. Since only the primary reference is utilized, no separate motivation or combination is required and that of the parent claim is hereby incorporated by reference without further comment.

23. As to claim 20,

The program product of claim 18, further comprising program code for displaying a template image that is associated with the composite image template.

Reference Yokouchi very clearly teaches a thumbnail system for displaying composite image templates in Fig. 11 and discusses the system in 0130 and provides examples of its use in 0137-0138. This would comprise displaying a template image that is associated with the composite image template. Reference Anderson clearly teaches (0006-0007, 0031-0034) that image files are associated with plane files for template construction via a system of tags embedded in the files. This clearly meets the above-recited limitations; also, Anderson in Figs. 6A and 6B clearly shows how each plane file can have one or a plurality of image files associated with it. In Fig. 6, the images that make up the background are displayed. It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the image templates of Yokouchi with those of Anderson, since Anderson explicitly teaches saving and displaying images (0047, image files are stored separately from combination instructions), which would allow manipulation of the composited images at a later time, and their use in later templates, as well as utilizing the three-layer image compositing scheme, which would allow the use of multi-layer templates, which would be an important improvement over Yokouchi. [Software is no different than method, as both are implemented in software, and it is a fundamental of the software art that one can build software having any combination of modules that will perform the same functions, thus taking care of any potential limitations there. Also, as discussed in the rejection to claim 16, both references teach software anyway, and software can be configured to

have any desired number of modules or code, so as long as the functionality is achieved, the structure of the software is irrelevant.]

24. As to claim 21,

The system of claim 11, wherein at least one of the at least one image area is not rectangular.

The limitation would be obvious for several reasons. Firstly, Yokouchi teaches in for example Fig. 18 that a template file is composed of various components including one labeled 'VALID AREA' wherein various coordinates are noted therein. These coordinates comprise the path traced to generate the valid area. Anderson in Fig. 9 teaches a similar concept. As such, it would be obvious that another set of coordinates could be used to create a non-rectangular area. Further, the use of a non-rectangular area would be obvious to one of ordinary skill in the art. Further, the shape of the region is a design choice only and does not effect the functioning of the system. Under standard legal doctrine, for example *In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955), and *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), where changing the size or shape of an object did not make the new object patentably distinct.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

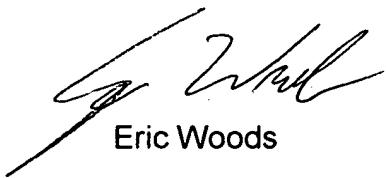
§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric V. Woods whose telephone number is 571-272-7775. The examiner can normally be reached on M-F 7:30-4:30 alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Razavi can be reached on 571-272-7664. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Eric Woods

  
Jeffrey A. Bries  
PRIMARY EXAMINER

June 18, 2005